

Office Action Summary	Application No. 10/560,904	Applicant(s) BONZI, IVAN	
	Examiner Erica E. Cadugan	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 86-156 and 158-170 is/are pending in the application.
- 4a) Of the above claim(s) 95-122, 124-156 and 158-170 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 86-94 and 123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the invention of Group I, and the first species (i.e., the species of Figures 3-6) in the reply filed on May 15, 2010 is acknowledged. In the reply submitted on August 24, 2010, Applicant indicated that claims 86-94 and 123 are readable on the elected species.
2. Thus, claims 95-122, 124-156, and 158-170 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 12, 2010.

Information Disclosure Statement

3. As noted in the attached Interview Summary form, on November 9, 2010, Examiner contacted Applicant's representative to request that Applicant's representative fax a courtesy copy of the cited non-patent literature Degarmo article, cited on the search report of the PCT of which the present application is the national stage, and also cited in the Information Disclosure Statement (IDS) submitted December 16, 2005. Examiner noted that the Degarmo article had not been received by the USPTO from the IB. Applicant's representative subsequently faxed the Examiner the requested courtesy copy of the Degarmo article.
4. In order to be able to have the Degarmo article scanned into the file of the present case, Examiner is lining through the Degarmo citation on the IDS of December 16, 2005, and is citing it on the attached Notice of References Cited. In other words, even though it has been lined

Art Unit: 3726

through on the IDS, it has been considered and is being made of record on the attached Notice of References Cited.

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Specifically, page 26 refers to WO 99/17911, not cited.

Priority

6. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Italy on June 19, 2003. It is noted that, to date, no certified copy of the Italian application has been received by the USPTO. It is also noted that since the present case is a national stage application filed under 35 USC 371, it is not Applicant's burden to supply the certified copy of the Italian application. It is instead WIPO's burden to provide such copy.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 86-94 and 123 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 86, the claim sets forth "an adjustable member movable transversely of said registration direction so as to be operationally associatable with said toolholder element and an

Art Unit: 3726

abutting member suitable for tightening said toolholder element against said adjustable member”. It is unclear as set forth in the claim whether the abutting member is merely intended to be another element in a list of elements, or whether the claim is intended to set forth that the abutting member is also “operationally associatable” with the “adjustable member”.

In claim 87 (multiple occurrences within the claim) and in claim 89, there is no axis or frame of reference provided in the claim for determining what is meant by “tilted”, i.e., tilted with respect to what axis or frame of reference?

In claim 87, it is unclear as set forth in the claim whether the "sliding direction" of the adjustable member is intended to be the same as or in addition to the direction of transverse movability of the adjustable member that was previously set forth in claim 86. If, as it appears, the claims are intended to refer to the same direction, Examiner suggests tying the two together, such as, for example, by setting forth in claim 86 that the adjustable member is movable “in a sliding direction” transversely to said registration direction, and then changing “a sliding direction” in line 2 of claim 87 to --the sliding direction-- or --said sliding direction--.

In claim 89, line 3, “said active surface” lacks sufficient antecedent basis in the claim, noting that plural “active” surfaces have been previously set forth in the claim (see claim 89, lines 2-3 and claim 87, lines 3-4).

Claim 91 recites the limitation "said apparatus" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 92 recites the limitation "said apparatus" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

Art Unit: 3726

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

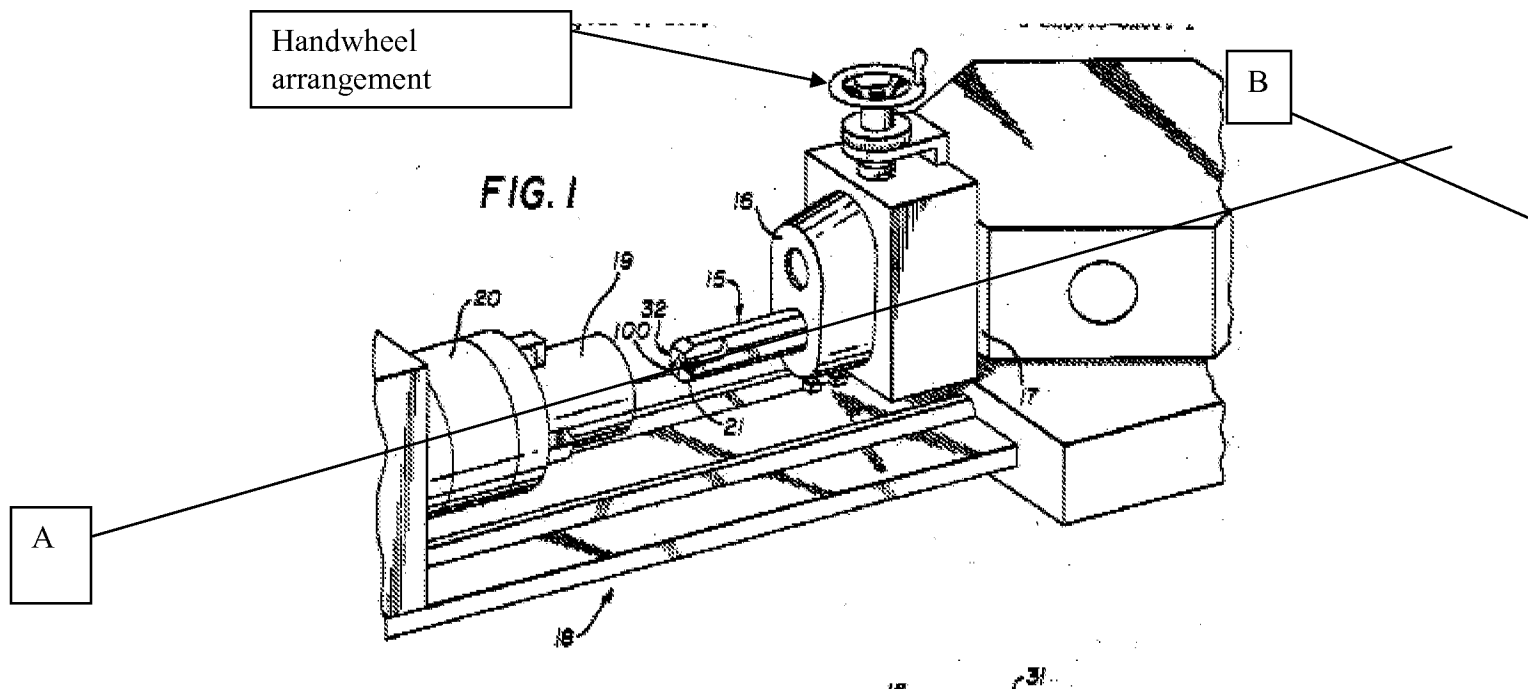
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 86-87, 89-94 and 123, as best understood in light of the rejections under 35 USC 112 set forth above, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,492,709 to Le Barre.

Le Barre teaches a device for positioning tool 63 in relation to an object 19 (Figure 1) to be processed, the device including a tool holder element 21 "suitable" for bearing the tool 63 (see Figures 2-3, for example) and movable along a registration direction (labeled "B" in the reproduction of Figure 1 below, which direction B is the horizontal direction that is orthogonal to the longitudinal direction of the overall device, labeled "A" below, and which direction B is the vertical direction with respect to Figure 4, and extends perpendicularly to the paper with respect to Figure 3) via the use of camming screw 35/36/37 (Figures 4-5 and 11 and col. 3, line 56 through col. 4, line 17, for example, and particularly col. 3, line 71 through col. 4, line 8).

Art Unit: 3726



Note that the tool 63 is able to be moved (as broadly claimed) in that B (registration) direction “towards and away” from a workpiece or object held at 20 at least in that, for example, the chuck of spindle 20 is inherently capable of holding whatever type or configuration of circular workpiece is presented thereto for holding, i.e., the chuck clamping arrangement is blind as to the workpiece it clamps, but will instead clamp whatever workpiece it comes into clamping contact with. That said, particularly noting that a cap has a circular periphery, as does the workpiece 19 shown by Le Barre, the chuck of spindle 20 is considered to be capable of clamping the circular periphery of a circular cap (including in the position wherein the interior of the cap faces towards the boring bar 15 shown in Figure 1). Note that in such a circumstance, when the tool 63 is located at a position that is within the cap walls, moving the tool in the B (registration) direction would move the tool 63 towards or away from the (walls of) the cap workpiece. Note that this discussion merely provides an example of a workpiece that the chuck

Art Unit: 3726

of spindle 20 is capable of holding that illustrates that the tool 63 is able to be "moved towards and away from" such a workpiece in the B registration direction as claimed.

The aforescribed camming screw 35/36/37 constitutes the claimed "adjustable member", noting that the movement of the screw in the left-right direction with respect to Figure 4 (which is direction A as labeled in Figure 1 above) to screw or unscrew the camming screw is a movement of the camming screw in a direction "transverse" with respect to the aforescribed "registration direction" B. Note that the camming screw 35/36/37 is movable in the A direction so as to be "operationally associatable" with the toolholder element 21 (see Figure 4, for example).

Additionally, there is an abutting member 65 suitable for tightening the tool holder element 21 (via screw 67), and abutting member 65 is ultimately "against" the adjustable member 35/36/37 (via intervening structure 21). The tool holder element 21 is interposed between the abutting member 65 and the adjustable member 35/36/37 in the registration direction, as shown in Figure 4, noting that the vertical direction with respect to Figure 4 is the registration direction, and that the upper (with respect to Figure 4) portion of tool holder 21 (which is the portion of 21 contacted by the lead line of element 56 in Figure 4) is interposed between 65 and 35/36/37 along that vertical direction in Figure 4.

Re claim 87, the adjustable member 35/36/37 includes a "block" 36 that is "actuated to slide" in a sliding direction (i.e., the horizontal direction with respect to Figure 4, which is direction A described previously) by an "adjusting arrangement" in the form of a hex wrench that engages 36 at wrench opening 35a (Figures 4-5 and col. 2, lines 51-55, for example). Note that "block" 36 is provided with a "tilted face" 37 that is "suitable for interacting with a

Art Unit: 3726

correspondingly tilted active surface” 59 of the toolholder element 21 (see at least Figures 4 and 11, for example).

Regarding claim 89, the abutting member 65 has a "tilted" face, such as the left face of rib 66 of member 65 (left with respect to Figure 3), which face is “tilted” with respect to the sliding direction A, for example (see Figure 3, noting that the sliding direction in Figure 3 would be the horizontal left/right direction). The aforescribed tilted face of 65/66 is “suitable for interacting” with a further correspondingly tilted “active” surface (at 57) of the toolholder 21 (see Figure 2 also). Note that the further correspondingly tilted active surface at 57 is “opposite” the “active surface” at 59 of the toolholder element 21, noting that the surface at 59 is towards the upper (with respect to Figure 4) end of 21, and the surface at 57 has portions at the lower end (lower with respect to Figure 4) of 21.

Re claim 90, note that as set forth in the claim, the block member 36 (with surface 37) can be considered, by itself, to constitute the claimed "block" or “adjusting member”. The adjusting arrangement as claimed can be considered to include both the aforescribed wrench, as well as the threaded screw member 35 portion, as both elements are necessary to perform the adjustment. That said, note that, as broadly claimed, the screw member 35 is considered to be “rotatingly coupled” with the block 36, noting that 35 is coupled to 36 so as to rotate therewith.

Re claim 91, see Figure 4. Note that the member 38 is considered a “frame” arrangement of the “apparatus” 15, for example, and that the exterior surface of 37 labeled at 37a in Figure 4 slides on the inside surface of member 38 as 35/36/37 moves in the direction A (Figures 2 and 4, for example).

Art Unit: 3726

Re claim 92, as broadly claimed, note that abutting member 65 is able to slide on a “frame arrangement” 57/56 of the “apparatus”, such as apparatus 15, for example (at the very least as 65 is being provided to element 21, for example). See Figure 2 and also col. 3, lines 30-32, for example.

Re claim 93, as broadly claimed, the bolt 67 can be considered an “actuating device” that is arranged to transfer the abutting member 65 between a work (or clamping) position wherein the abutting member 65 “interacts with” the toolholder element 21, and a rest (or non-clamping) position, wherein the abutting member 65 does not interact with the toolholder element 21, simply by screwing or unscrewing the bolt 67 far enough.

Re claim 94, as shown in Figure 1, the turret head 17 includes a handwheel arrangement (labeled in the reproduction of Figure 1 above) for moving at least ultimately the boring bar 15 and tool 63 up and down with respect to the workpiece 19 (see at least Figure 1). Note that such movement would result in the vertical movement of the toolholder element 21 (see Figure 1), and that the actuating device in the form of the handwheel doesn't care whether the abutting member 65 is in the rest position or not, i.e., the handwheel is considered to be capable of performing the function of moving the toolholder element 21 when the abutting member 65 is in the rest position because the vertical movement caused by the handwheel is unaffected by which position element 65 is in.

Re claim 123, it is noted that the tool 63 is a cutting tool (see at least col. 3, lines 20-24, for example). The cutting tool 63 is considered to be capable of performing the claimed intended use of etching and the claimed intended use of being “for the production of caps”, as broadly claimed, noting that a cutting edge is blind as to the workpiece it cuts, i.e., it will cut whatever

Art Unit: 3726

workpiece it comes into operative contact with, including a "cap" workpiece (particularly noting that the chuck of spindle 20 is considered to be capable of holding a cap type workpiece as described previously). Additionally, whether the cutter is used to perform an "etching" operation is merely a function of cutting depth, and thus, the cutter taught by Le Barre is considered to be capable of performing an etching operation, simply by utilizing it at an appropriate cutting depth to "etch".

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 90, in the alternative, claim 90, as best understood in light of the rejections under 35 USC 112 set forth above, is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,492,709 to Le Barre as applied to at least claims 86-87 above.

Le Barre teaches all aspects of the presently-claimed invention as set forth above, but is silent as to the size of the screw member 35.

Thus, in the event that the screw member 35 is not considered to be of a size so as to be considered "micrometric", it would have been obvious to have scaled the device (and thus the screw) to whatever size was desired or expedient to an end user, including that which would result in the screw being a "micrometric" sized screw, noting that such a modification would have involved a mere change in the size of a component. A change in size is generally

Art Unit: 3726

recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Allowable Subject Matter

13. Claim 88, as best understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on Monday-Thursday, 5:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

Art Unit: 3726

like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erica E Cadugan/
Primary Examiner
Art Unit 3726

eec
November 16, 2010